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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/971,254

Applicant(s)

PERCUTANIX, INC.

Examiner

MEDLEY, M. B.

Group Art Unit

1721

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO 152

SEE OFFICE ACTION ON THE FOLLOWING PAGES

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The present US Application 08/971,254 filed on November 17, 1999 construed as a request to convert the application to a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b) for a continued Prosecution Application (CPA) based on Parent Application 08/544,345 filed on October 17, 1995 now US. Patent No. 08/544,345 is acceptable and a CPA has been established. An action on the CPA follows:

Applicants are required to amend page 1 line 1 after the title of the instant application to include the continuation data based on the Parent Application mentioned in the declaration.

The Draftsperson's Patent Drawing review Form PTO 948 accepting the Drawing is enclosed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,689,031.

Although the conflicting claims are not identical, they are not patentably distinct from each

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Fischer-Tropsch process and a process for producing said material are the same and similar distillate fraction and process of Patentees and are not patentably distinct.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammer et al 4,919,786 in view of Dinh et al 4,125,566.

Hamner teaches a material useful as a fuel heavier than gasoline or as a blending component for a distillate fuel comprising a 250-700°F fraction derived from a Fischer-Tropsch catalyst process, and prepare said material. Patentees further teach a process for hydro isomerization of wax to produce middle distillate products which differ from the claimed process in that each recycling step is not disclosed, note column 2, line 65 to column 4, lines 1-3 and 46-64 and the claims, especially claim 22.

It is obvious to one of ordinary skill in the art that a catalyst for upgrading effluents from synthesis of Fischer-Tropsch type would be obvious in view of Dinh et al. Dinh et al teach a process for upgrading effluents from synthesis of

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Fischer-Tropsch type produced in different recycling steps in the presence of hydrofluoric or sulfuric acid with or without the presence of a Lewis acid (column 4, lines 29-52, column 2, lines 61 to column 3, lines 1-45 and abstract). It would have been obvious to one of ordinary skill in the art to add a variety of separation and recycle steps of Dinh et al to the process of Hamner et al to produce the material for a fuel because both processes remove the oxygenates during the separation and recycling steps. Note that it has been held that the substitution of one known equivalent technique for another may be obvious even if the prior art does not expressly suggest the substitution. Ex parte Novak 16 USPQ 2d 2041 (BPAI 1989). In re Leshin 125 USPQ 416; Lyon v. Bausch & Lomb 106 USPQ 1; Graver Tank Manufacturing Co., V. Linde Air Products Co. 85 USPQ 328 (Supr. Ct.). Applicants have not shown that there is any criticality in its two-step process for removing oxygenates from a Fischer-Tropsch catalyst process as opposed to Hamner et al one process or Hamner et al process modified with Dinh et al process for removing oxygenates from a Fischer-Tropsch catalyst process.

The references cited but not applied further teach fuel composition comprising additives of the same nature as claimed by Applicants.

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

Medley/mm

December 10, 1998

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER
GROUP 1100